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REMARKS

Claim 1-7, 9-19 and 21-26 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

Claims 1-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the prior art disclosed by the Applicants in view of U.S. Patent No. 4,602,176 to Baker and U.S. Patent No. 5,224,429 to Borgman et al. The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP §2143.01 provides further guidance as to what is necessary in showing that there was motivation known in the prior art to modify a reference teaching. Specifically, MPEP §2143.01 states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992); M.P.E.P. §2142. Applicants respectfully assert that the Examiner has not yet met the Examiner's burden of establishing a *prima facie* case of obviousness with respect to the rejected claims. Consequently, the Examiner's rejection of the subject claims is inappropriate, and should be withdrawn.

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In regard to the first criterion of obviousness, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. According to the Office Action, a combination of the prior art disclosed by the Applicants, the Baker '176 patent and the Borgman et al. '326 patent disclose all of the features of the claims except for "a pin with a majority of its tapered portion in contact with the elastomeric element." The Office Action thereafter states that "Baker does disclose that it is conventional in the prior art to make the grommet bore substantially the same as the shape of the pin" and it therefore "would have been obvious to one of ordinary skill in the art at the time of the present invention to have utilized a bore such as that which is conventional in the prior art as a matter of design preference."

First, Applicant notes that it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965); see also *In re Mercer*, 515 F.2d 1161, 1165-66, 185 U.S.P.Q. 774, 778 (C.C.P.A. 1975). Second, changing the function of a combination is more than a mere design choice and there must be some motivation or suggestion for making such a change. See *In re Chu*, 36 U.S.P.Q.2d 1089 (Fed. Cir. 1995). Finally, the Baker '176 patent teaches away from any grommet that has substantially the same shape of a pin wherein the pin tapers. The Baker '176 patent teaches that:

grommet portion 49 is clear of stud 25, and more particularly, clear of the smaller diameter stud portion 47, when the grommet is at least partially compressed such that the grommet portion 49 is substantially free to elastically flex in transverse direction relative to the stud without [sic] interference from stud 25. Thus, the grommet is able to damp both acoustical noise and mechanical vibration in a surprising and unexpected fashion, as compared to conventional prior art studs and grommets, as generally shown in FIG. 6, in which the grommet bore is substantially the same diameter as the stud along the entire length of the grommet bore.

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Lines 60-68 of column 4 and lines 1-4 of column 5 of the Baker '176 patent. Therefore, the Baker '176 patent specifically teaches that its stud 25 with an end portion 47 of a smaller diameter cross section is specifically made to be spaced from the inner surface of the grommet bore 31 to improve acoustical noise and mechanical vibration dampening. Therefore, the Baker '176 patent teaches away from the modification as set forth in the Office Action. Furthermore, in the prior art that the Baker '176 patent describes as being undesirable (and therefore teaches against using), the threaded portion 25'' is not tapered. Therefore, the Baker '176 patent teaches that the outer end portion 47 having a smaller diameter cross section is only needed when it is spaced from the grommet bore 31. Accordingly, there is no suggestion or motivation, either in the references themselves or to the knowledge of one of ordinary skill in the art, to combine the references as set forth in the Office Action. Accordingly, claims 1-7, 9-19 and 21-23 are in condition for allowance.

New claims 24-26 are also believed to define patentable subject matter.

All pending claims 1-7, 9-19 and 21-26 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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